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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/525,981

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Kyoko Ishimoto

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07/08/2009

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EXAMINER

DEES, NIKKI H

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/525,981	<b>Applicant(s)</b> ISHIMOTO ET AL.	
	<b>Examiner</b> Nikki H. Dees	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 23, 2009, has been entered.

2. Claims 1 and 3-6 are currently pending in the Application. Claim 2 has been cancelled. The previous double patenting rejection over 10/585,661 has been withdrawn in view of the terminal disclaimer filed on March 23, 2009. The previous 103 rejection of claims 1-6 has been withdrawn in view of Applicant's arguments and the cancellation of claim 2.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter (3,749,588) in view of Wong et al. (US 2001/0018197).

Art Unit: 1794

5. Hunter teaches a process for producing acidic gel foods comprising soy protein at about 0.3 to 10 wt% protein. The invention further comprises an anionic polymer (pectin) in an amount ranging from 12 to 20 wt% (col. 2 lines 14-17). The gel food may be acidified with citric acid or any acceptable acid to obtain the desired pH (col. 3 lines 47-50). Hunter speaks to the problems with the prior art and the precipitation of proteins in jelly products due to their acidity. His invention provides for a clear appearance while providing a protein supplemented food product (col. 1 lines 29-50).

6. Hunter speaks to the process by which the acid-soluble soy-protein is produced, stating that the process yields 67% protein that is soluble at pH 3 and two-thirds of the protein produced by the process may be added to the jelly (col. 3 lines 17-23). The acid-soluble protein added to the jelly would thus be expected to be entirely soluble at pH 3 as the insoluble portion would not be added.

7. Regarding the gel being formed by gelation of the acid-soluble soybean protein, as the final composition of Hunter is a rigid gel (col. 2 lines 15-17), the acid-soluble soybean protein present in the final gelled composition, and therefore the soybean protein is considered to be gelled by gelation.

8. Hunter does not teach the amount of acid to be added to the solution in terms of concentration. It is only reported to adjust the pH. However, given that the acid-gel food product of Hunter is substantially similar to that as claimed by Applicants, absent any clear and convincing arguments and/or evidence to the contrary it would be expected that the amount of acid used by Hunter is the same as that claimed by Applicants.

9. Hunter is silent as to the soybean protein being obtained by removal or inactivation of polyanionic substances or the addition of polycationic substances.
10. Wong et al. teach the production of a soybean protein produced by exposing the soybean protein to phytase. The phytase serves to inactivate the polyanionic substance phytic acid (abstract). The soy protein is used in foodstuffs where ultrapure proteins are desired [0001].
11. One of ordinary skill in the art at the time the invention was made wishing to produce the soy protein jelly food of Hunter with a purified protein would have found it obvious to include a soy protein such as that taught by Wong et al. in order to provide a soy protein jelly food having fewer impurities. As the foodstuff of Hunter comprises soy protein, the substitution of the soy protein of Wong et al. would not have required undue experimentation and there would have been a reasonable expectation that soy protein product of Hunter maintain its favorable textural and organoleptic properties.

#### ***Allowable Subject Matter***

12. Claim 6 is considered to be allowable over the prior art.
- 13.** The following is a statement of reasons for the indication of allowable subject matter: The previously cited prior art of Hunter (3,749,588) fails to teach a process for producing an acidic gel food comprising soy bean protein where the protein is heated at the temperature and for the time as required by the present claim 6.

#### **14. *Response to Arguments***

15. Applicant's arguments filed April 23, 2009, have been fully considered. They are persuasive in overcoming the rejection of claim 6.

16. Applicant argues that the soybean protein taught by Hunter does not meet the solubility as required by the instant claims (Remarks, pp. 3-4).

17. As stated in the rejection *supra*, the acid-soluble protein of Hunter added to the jelly would be expected to be entirely soluble at pH 3 as the insoluble portion would not be added. The instant claims do not require that an insoluble portion of the protein not be removed.

#### ***Terminal Disclaimer***

18. The terminal disclaimer filed on March 23, 2009, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on Application Number 10/585,661 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Double Patenting***

19. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140

Art Unit: 1794

F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

20. Claims 1 and 3-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,465,470.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the process of the instant claims requires soy protein processed by the method of the conflicting claim. As the conflicting claim provides a soy protein material having good solubility in the pH range of the instant claims, it would have been obvious to utilize the soy protein material produced by the conflicting claim in the process of the instant claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikki H. Dees whose telephone number is (571) 270-3435. The examiner can normally be reached on Monday-Friday 7:30-5:00 EST (second Friday off).

Art Unit: 1794

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. H. D./  
/Lien T Tran/  
Primary Examiner, Art Unit 1794

Nikki H. Dees  
Examiner  
Art Unit 1794